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In the

Supreme Court of the United States
October Term, 1999

Wal-Mart Stores, Inc. v. Samara Brothers, Inc.

On Writ of Certiorari to the United States Court of Appeals
for the Second Circuit

Brief *Amicus Curiae* of Scott P. Zimmerman,

Urging Reversal and Remand to Reconsider and Apply A Proper Test of Inherent Distinctiveness

Submitted by Charles W. Calkins

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INTEREST OF THE AMICUS CURIAE

This brief is submitted by Charles Calkins on behalf of Scott P. Zimmerman.[1] The *amicus* is interested in the proper identification and in the proper application of a test for inherently distinctive trade dress. This brief is submitted to provide the Court with the assistance of one who practices before the United States Patent and Trademark Office and one who studies the intersection of utility patents, design patents, and trademarks. The *amicus* has no financial interest in the outcome of this case, and the *amicus* takes no position on the inherent distinctiveness of the appellee's garments.

CONSENT OF THE PARTIES

Each party has consented to this brief. Messrs. Coston and Riback both consented by email, and a written acknowledgement was mailed to each. Copies of each email and each acknowledgement are included with the packaged briefs.

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[1] Scott P. Zimmerman has authored this brief in whole. No other person, party, or counsel has made a monetary contribution to the preparation or submission of this brief. *See* SUP. CT. R. 37.6 (1999).

SUMMARY OF THE ARGUMENT

1. Inherently Distinctive Trade Dress Should Not Consider "Intent"

The Second Circuit erroneously considered Samara's intent to distinguish their trade dress. One of the statutory requirements, according to the Second Circuit, is that a person "use" or "intend to use" a mark to identify and to distinguish goods. There is, however, no statutory requirement that a person "intend" to identify or to distinguish their goods. Section 45 of the Lanham Act does define a "trademark" using "intention to use." Yet this definition must be read and understood in the context of "intent to use" trademark applications. An intent-to-use trademark application confers no Lanham Act rights until the mark is actually "in use in commerce." A person's intentions are statutorily irrelevant and, more important, are not protectable by the Lanham Act. The Second Circuit erred when saying Samara's intent to

identify and to distinguish Samara's trade dress satisfied the Lanham Act's statutory requirement.

2. The Second Circuit's Test for Inherently Distinctive Trade Dress Is Erroneous

The Second Circuit's test for inherent distinctiveness is also erroneous. The Second Circuit's test is constructed upon a faulty premise, which is that a product feature cannot presumptively identify the product's source. This presumption, first announced in *Duraco*, is contrary to the Supreme Court's *Two Pesos* opinion. The Second Circuit's test for inherently distinctive product configurations is, therefore, premised upon an erroneous view of the law.

3. *Abercrombie* Is Applicable When The Competitive Field Is Considered

Abercrombie is admittedly difficult to apply to product designs. Whether a product design is "suggestive" or "fanciful" or "arbitrary" may often seem a wholly subjective inquiry. The *amicus* shows, however, that *Abercrombie* is applicable and is workable when considered in view of the competitive field.

The *Abercrombie* analysis must be applied to the combined features of the trade dress. Each allegedly distinctive product design feature, or product packaging feature, must be identified before any analysis can be applied. If other courts have considered "the product itself," then those courts have impermissibly narrowed the Court's recent explanation of trade dress. The analysis must first identify the alleged inherently distinctive feature(s) or combination of features.

Once the trade dress features have been identified, the alleged inherently distinctive trade dress must be compared with the competitive field. The trade dress is the "total image and overall appearance" of the product design. This "total image"

must be distinctive within the competitive field. Although each individual trade dress feature may be old in the competitive field, or even ubiquitous, the total combination may still be distinctive.

Once the competitive field is known, the *Abercrombie* factors are very applicable. The competitive field often segregates the *Abercrombie* categories. "Fanciful" product designs, for example, have at least one feature that is newly invented and unrelated to the product. "Arbitrary" product designs could have at least one feature that is borrowed from other product fields or other contexts. "Arbitrary" product designs could also have features that are commonly found in the competitive field, however, these features are distinctively combined.

"Suggestive" and "descriptive" product designs, like "suggestive" and "descriptive" word marks, are difficult to demarcate. A "suggestive" product design is a combination of features that requires "imagination, thought and perception" to determine the nature of the goods. A "descriptive" product design

includes a combination of features that describe a characteristic of the product. A "descriptive" product design requires secondary meaning. Although the "suggestive" and "descriptive" categories have always been difficult to demarcate, knowledge of the competitive field could greatly clarify the *Abercrombie* classification.

The competitive field quickly identifies "generic" product designs. Any combination of product features that commonly refers to the product or product class is "generic." Knowledge of the competitive field also allows the factfinder to quickly determine what combination of features has become ubiquitous. "Generic" product designs, when compared with the competitive field, are now easily segregated from the competitive field.

The competitive field also helps determine when trade dress merely follows a trend or when trade dress departs from the field. Trade dress which departs from the competitive field is more deserving of inherent distinctiveness. "Fanciful" trade dress,

as mentioned above, has features that are newly invented and also unrelated to the product. "Arbitrary" trade dress has at least one feature that is borrowed from other product fields or other contexts. Because "fanciful" trade dress includes at least one newly invented feature, or because "arbitrary" trade dress includes at least one feature not found in the field, fanciful and arbitrary trade dress is easily identified as a "departure" from the field and deserves protection *ab initio*.

Some "arbitrary" trade dress, however, is not protected *ab initio*. "Arbitrary" product designs could also have features that are commonly found in the competitive field, however, these features are distinctively combined. A combination of common features, although novel, should not be protected *ab initio* if the combination follows a trend in the competitive field. Not every trivial, but novel, combination of common features deserves protection *ab initio*. Trade dress which is a mere refinement of a trend in the field cannot be inherently distinctive. Trends in the

competitive field can separate inherently distinctive trade dress from that requiring secondary meaning.

4. One Last Comment: The Above Test For Inherent Distinctiveness Is Applicable To Product Design And Product Packaging

The *amicus* cautions the Court. The Court must clarify that the *Abercrombie* analysis discussed above is applicable to both product design and product packaging. Many courts and commentators distinguish between inherently distinctive "product design" and inherently distinctive "product packaging." If the Court only discusses "product design," the door will be open for continued disagreement over the test for inherently distinctive "product packaging." There is, for example, much disagreement whether the restaurant trade dress in *Two Pesos* was "product packaging" or "product design." The Court would eliminate continued confusion and disagreement by expressly deciding the *Abercrombie* factors, when applied in view of the product field, are applicable to both "product design" and "product packaging."

THE ARGUMENT

1. INHERENT DISTINCTIVENESS DOES NOT REQUIRE THAT A PERSON "INTEND TO USE" TRADE DRESS AS AN IDENTIFIER OF GOODS

The Second Circuit erroneously considered Samara's intent to distinguish their trade dress. There is no statutory requirement that a person "intend" to identify or to distinguish their goods. Section 45 of the Lanham Act does define a "trademark" using "intention to use." Yet this definition must be read and understood in the context of "intent to use" trademark applications. An intent-to-use trademark application confers no Lanham Act rights until the mark is actually "in use in commerce." A person's intentions are statutorily irrelevant and, more important, are not protectable by the Lanham Act. The Second Circuit erred when saying Samara's intent to identify and to distinguish Samara's trade dress satisfied the Lanham Act's statutory requirement.

The Second Circuit says Samara's garments satisfy the statutory requirements for trade dress protection. One of the statutory requirements, according to the Second Circuit, is that a person "use" or "intend to use" a mark to identify and to distinguish goods. *See Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 49 U.S.P.Q.2d (BNA) 1260, 1264 (2d Cir. 1998). *See also Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1008, 36 U.S.P.Q.2d (BNA) 1737, 1747 (2d Cir. 1995); *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 378 n.3, 42 U.S.P.Q.2d (BNA) 1641, 1644 (2d Cir. 1997). Because Samara intentionally designed their garments to be recognized in the marketplace, according to the Second Circuit, Samara's trade dress satisfies one of the statutory requirements. *Id.*

The Second Circuit, however, misunderstands the Lanham Act statutory requirements. There is no statutory requirement that a person "intend" to identify or distinguish their goods. Section 45 of the Lanham Act does define a "trademark" using "intention to

use." *See* 15 U.S.C. § 1127 (1996). Yet this definition must be read and understood in the context of "intent to use" trademark applications. *See* 15 U.S.C. § 1051(b) (1996). When Section 45 is clearly understood, the Second Circuit will realize there is no statutory "intent" requirement for trade dress protection.

An intent-to-use trademark application allows an applicant to reserve a trademark. *Id.* There are two types of trademark applications. Trademark applications can be based upon actual "use of the mark in commerce." *See* 15 U.S.C. § 1051(a)(1)(A) (1996). Trademark applications may also be based upon a "bona fide intention to use the mark in commerce." *See* 15 U.S.C. § 1051(b)(1)(A) (1996). An "intent-to-use" trademark application can be filed without having actually used the mark in commerce. *Id.* Although an intent-to-use application may be filed, someone must later verify that the mark is actually used in commerce. *See* 15 U.S.C. § 1051(d) (1996).

An intent-to-use application, more importantly, is not protectable under the Lanham Act. Every trademark must first be "registered" before an infringement action can be brought. *See* 15 U.S.C. § 1114 (1)(a) (1996). An intent-to-use application, however, is not "registered" until the applicant files a verified statement that the mark is actually used in commerce. *See* 15 U.S.C. § 1051(b)(1)(A) & § 1051(d) (1996). Although an intent-to-use application may be filed, the Lanham Act expressly states "no mark shall be registered until the applicant has met the requirements of subsection (d)," which, of course, is the verified statement of actual use in commerce. *Id.* An intent-to-use trademark application, therefore, confers no Lanham Act rights until the mark is actually "in use in commerce."[2] *See* 15 U.S.C. § 1051(d)(1) (1996). *See also* JANE C. GINSBERG, JESSICA LITMAN, DAVID GOLDBERG, & ARTHUR J. GREENBAUM, TRADEMARK AND UNFAIR COMPETITION LAW 191-201 (1996).

[2] Even an unregistered trademark must still satisfy the use-in-commerce requirement. *See* 15 U.S.C. § 1125(a)(1) (1996).

There can be, therefore, no statutory requirement that a person "intend" to identify or distinguish their goods. The Lanham Act requires actual "use in commerce." A person's intentions are statutorily irrelevant and, more important, are not protectable by the Lanham Act. The Second Circuit erred by considering Samara's intent to identify and to distinguish their children's garments.

2. THE SECOND CIRCUIT'S TEST FOR INHERENT DISTINCTIVENESS IGNORES *TWO PESOS* AND IS PREMISED UPON AN ERRONEOUS VIEW OF THE LAW

This section will show the Second Circuit's test for inherent distinctiveness is erroneous. The Second Circuit's test is constructed upon a faulty premise, which is that a product feature cannot presumptively identify the product's source. This presumption, first announced in *Duraco*, is contrary to the Supreme Court's *Two Pesos* opinion. The Second Circuit's test

for inherently distinctive product configurations is, therefore, premised upon an erroneous view of the law.

The Second Circuit has ignored Supreme Court mandate. The Second Circuit's test for inherent distinctiveness is whether "a product's design . . . 'was likely to be understood as an indicator of the product's source.'" *Samara,* 49 U.S.P.Q.2d at 1264. This test focuses on whether a consumer perceives the product feature as an indicator of source, or whether the product feature simply makes the product more desirable regardless of source. *See Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431, 1450, 32 U.S.P.Q.2d (BNA) 1724, 1739 (3d Cir. 1994). This test has an underlying, but faulty, premise first stated by the *Duraco* court: one cannot "automatically conclude" that a product feature presumptively identifies the product's source. *Id.* at 1441, 32 U.S.P.Q.2d at 1731. This premise is exactly contrary to the Supreme Court's prior mandate in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).

Two Pesos explicitly says an inherently distinctive product feature is protected *ab initio*. "If a verbal or symbolic mark *or the features of a product design* may be registered under § 2, it necessarily is a mark 'by which the goods of the applicant may be distinguished from the goods of others.'" *Two Pesos,* 505 U.S. at 772, 23 U.S.P.Q.2d at 1085 (quoting 60 Stat. 428) (emphasis added). A product feature, even if not registered, "remain[s] inherently capable of distinguishing the goods of the users." *Id.*, 23 U.S.P.Q. at 1085. As Justice White noted, product features can be presumptively protected, and the underlying premise of the Second Circuit's test for inherently distinctive trade dress ignores the Court's mandate. The Second Circuit's test for inherently distinctive product configurations is, therefore, premised upon an erroneous view of the law.

3. THE *ABERCROMBIE* FACTORS ARE VERY APPLICABLE TO PRODUCT DESIGNS WHEN THE COMPETITIVE FIELD IS CONSIDERED

Abercrombie is admittedly difficult to apply to product designs. Whether a product design is "suggestive" or "fanciful" or "arbitrary" may often seem a wholly subjective inquiry. The *amicus* will show, however, that knowledge of the product field has nearly always been used to illuminate the inquiry. If the individual product design features are identified, and if the combined features are compared to the competitive field, then the *Abercrombie* factors are applicable and are workable.

A. A Properly Applied Analysis Focuses on The Product's Features and Not On The Product Itself

The analysis must be applied to the combined features of the trade dress. Each allegedly distinctive product design feature, or product packaging feature, must be identified before any analysis can be applied. *See, e.g., Two Pesos,* 505 U.S. at 765, 23 U.S.P.Q.2d at 1082; *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.,* 187 F.3d 363, 367, 51 U.S.P.Q.2d (BNA) 1609, 1610 (4th Cir. 1999) (finding a modern high-gloss polyester bedroom suite with classical elements, such as fluted, marble columns and

arches, was inherently distinctive). If other courts have considered "the product itself," *see Duraco,* 40 F.3d at 1438, 32 U.S.P.Q.2d at 1729, then those courts have impermissibly narrowed the Court's recent explanation of trade dress. *See Two Pesos,* 505 U.S. at 772, 23 U.S.P.Q.2d at 1085 (quoting 60 Stat. 428) (explaining "[i]f a verbal or symbolic mark *or the features of a product design* may be registered under § 2, it necessarily is a mark 'by which the goods of the applicant may be distinguished from the goods of others'") (emphasis added).

B. The Product's Combined Features Must Be Compared to the Field

Once the product design features have been identified, the alleged inherently distinctive trade dress must be compared with the competitive field. The trade dress is the "'total image and overall appearance'" of the product design. *See Two Pesos,* 505 U.S. at 764 n.1, 23 U.S.P.Q.2d at 1082 n.1 (quoting the district court's jury instructions). This "total image" must be distinctive

within the competitive field. Although each individual design feature may be old in the competitive field, or even ubiquitous, the total combination may still be distinctive.

Inherent distinctiveness has long been compared to the competitive field. The Supreme Court has already said a trademark distinguishes a name, device, or symbol "from like articles manufactured by others." *See Columbia Mill Co. v. Alcorn,* 150 U.S. 460 (1893). A polka-dotted household cleanser label distinguishes the product "from articles of like kind sold by others." *See In re Swift & Co.,* 106 U.S.P.Q. (BNA) 286, 289 (C.C.P.A. 1955). Judge Rich, in *In re Esso Standard Oil Co.,* found the "ESSO" label had "distinctive proportions and arrangement of elements" not found in the field. *See* 134 U.S.P.Q. (BNA) 402, 404 (C.C.P.A. 1962). Judge Rich, in dissent, felt the Seabrook Farms frozen food label was "inherently distinctive *in the field of frozen foods.*" *See Seabrook Foods, Inc. v. Bar-Well Foods Ltd.,* 196 U.S.P.Q. (BNA) 289, 293 (C.C.P.A. 1977) (J. Rich dissenting) (emphasis added). Judge Friendly even quoted a

generic mark is "'widely used by the general public *and people in the trade.*'" *See Abercrombie & Fitch Co. v. Hunting World, Inc.,* 189 U.S.P.Q. (BNA) 759, 766 (2d Cir. 1976) (emphasis added). A liquor bottle design, more recently, was unlike any industry practice. *See Paddington Corp. v. Attiki Importers & Distributors,* 27 U.S.P.Q.2d (BNA) 1189, 1193 (2d Cir. 1993). Knowledge of the competitive field greatly illuminates the distinctiveness of the trade dress.

C. Application of the *Abercrombie* Factors

Once the competitive field is known, the *Abercrombie* factors are very applicable. "Fanciful" product designs, for example, have at least one feature that is newly invented and unrelated to the product. "Fanciful" product designs, when compared with the competitive field, are now easily segregated from the competitive field.

"Arbitrary" product designs, similarly, are easily identified. "Arbitrary" product designs could have at least one feature that is borrowed from other product fields or other contexts. "Arbitrary" product designs could also have features that are commonly found in the competitive field, however, these features are distinctively combined. Knowledge of the competitive field, again, greatly illuminates the *Abercrombie* classification and objectifies the inquiry.

"Suggestive" and "descriptive" product designs, like "suggestive" and "descriptive" word marks, are difficult to demarcate. Courts and commentators have always had trouble demarcating the boundaries between these two classifications. *See, e.g., Abercrombie,* 189 U.S.P.Q. at 765; *In re Application of Reynolds Metals Co.*, 480 F.2d 902, 178 U.S.P.Q. (BNA) 296 (C.C.P.A. 1973) (finding BROWN-IN-BAG wordmark for plastic oven bags is "suggestive," while dissent found the mark to be "descriptive"). A "suggestive" product design is a combination of features that requires "imagination, thought and perception" to determine the nature of the goods. *See Abercrombie,* 189 U.S.P.Q.

at 765 (quoting *Stix Products, Inc. v. United Merchants & Manufacturers,* 295 F. Supp. 479, 488 (S.D.N.Y. 1968)). A "descriptive" product design includes a combination of features that describe a characteristic of the product. A "descriptive" product design may require secondary meaning. Although the "suggestive" and "descriptive" categories have always been difficult to demarcate, knowledge of the competitive field could greatly clarify the *Abercrombie* classification.

The competitive field quickly identifies "generic" product designs. Any combination of product features that commonly refers to the product or product class is "generic." Knowledge of the competitive field also allows the factfinder to quickly determine what combination of features has become ubiquitous. "Generic" product designs, when compared with the competitive field, are now easily segregated from the competitive field.

D. The Competitive Field Also Distinguishes Departures and Trends

The competitive field also helps determine when trade dress merely follows a trend or when trade dress departs from the field. Trade dress which departs from the competitive field is more deserving of inherent distinctiveness. Trade dress, however, which merely follows a trend in the field should require secondary meaning.

Abercrombie protects fanciful and arbitrary trade dress *ab initio*. "Fanciful" product designs, as mentioned in (C.) above, have features that are newly invented and also unrelated to the product. Because "fanciful" trade dress includes at least one newly invented feature, fanciful trade dress is easily identified as a "departure" from the field and deserves protection *ab initio*.

"Arbitrary" trade dress is also protected *ab initio*. "Arbitrary" product designs, as mention in (C.) above, have at least one feature that is borrowed from other product fields or other contexts. "Arbitrary" product designs could also have features that

are commonly found in the competitive field, however, these features are distinctively combined. Those product designs that borrow at least one feature from other product fields are, again, easily identified as a "departure" and deserve protection *ab initio*.

A combination of common features, although novel, should not be protected *ab initio* if the combination follows a trend in the competitive field. As some courts have already mentioned, not every trivial, but novel, combination of common features deserves protection *ab initio*. *See Ashley Furniture,* 187 F.3d at 374, 51 U.S.P.Q. at 1616; *Seabrook,* 196 U.S.P.Q. at 291. Those product designs that are a mere refinement of a trend in the field cannot be inherently distinctive. *See In re E.S. Robbins Corp.,* 30 U.S.P.Q.2d (BNA) 1540 (T.T.A.B. 1992) (finding although a floor mat was not identical to the competition, the floor mat only differed in shape). Trends in the competitive field can separate inherently distinctive trade dress from that requiring secondary meaning.

E. Once *Abercrombie* Is Applied In View Of The Competitive Field, Functional Features Are Considered

Established trademark principles exclude protection for functional features. *See,e.g., Qualitex Co. v. Jacobson Products Co.,* 514 U.S. 159, 164-65 (1995); *In re Morton-Norwich Products, Inc.,* 213 U.S.P.Q. (BNA) 9, 12-18 (C.C.P.A. 1982). The *amicus* shall not burden the Court with further recitation of this accepted trademark principle.

4. ONE LAST COMMENT: THE ABOVE TEST FOR INHERENT DISTINCTIVENESS IS APPLICABLE TO PRODUCT DESIGN AND PRODUCT PACKAGING

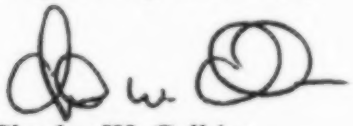
The *amicus* cautions the Court. The Court must clarify that the *Abercrombie* analysis discussed above is applicable to both product design and product packaging. Many courts and

commentators distinguish between inherently distinctive "product design" and inherently distinctive "product packaging." *See, e.g., Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.,* 111 F.3d 993, 42 U.S.P.Q. (BNA) 1348 (2d. Cir. 1997); *Ashley Furniture,* 187 F.3d at 365, 51 U.S.P.Q. at 1612. If the Court only discusses "product design," the door will be open for continued disagreement over the test for inherently distinctive "product packaging." There is, for example, much disagreement whether the restaurant trade dress in *Two Pesos* was "product packaging" or "product design." *See Ashley Furniture,* 187 F.3d at 366, 51 U.S.P.Q. at 1613. The Court would eliminate continued confusion and disagreement by expressly deciding the *Abercrombie* factors, when applied in view of the product field, are applicable to both "product design" and "product packaging."

CONCLUSION

For the foregoing reasons, the judgment below should be reversed and the case remanded for further proceedings.

Respectfully submitted,



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